

REMARKS

Claims 10, 15, 32 and 36-38 remain pending in the application.

Claims 10 and 32 are amended to recite that the p97 that is utilized in the claimed method or present in the claimed composition is "unconjugated to any moiety." Although there is not recitation of this specific phrase in the claims, Applicants submit that the specification makes quite clear throughout its text that p97 is used in this form. There is not a single instance in the specification where conjugation of p97 to any other moiety is described, and the protein is referred to consistently throughout the specification simply as "soluble p97". Also, many instances can be found describing addition of "p97 alone" to culture media or describing the effects of "p97 alone" in discussion of experimental results. See, e.g. page 45, lines 10-14, where it is described that, "While soluble p97 or plasminogen alone did not induce cell detachment, ...". Such description recites in positive terms that the soluble p97 is not covalently attached to any further substance, that is, it is "unconjugated to any further moiety."

Rejections for lack of novelty

Claims 32 and 36-38 stand rejected under 35 USC § 102(b) as being anticipated by Gabathuler. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

As has been previously explained, the rejection is made because the Examiner inappropriately interprets the claims as including p97 conjugated to some further substance. Applicants completely disagree with the Examiner's interpretation of the case law that the transitional phrase "comprising" in the claims allows the modification of a specifically described element to include further aspects. While it is so that the transition "comprising" when used in a method claim allows for inclusion of additional steps, it does **not** allow for inclusion of structures additional to those specifically recited for implementing a recited step. In this regard, Applicants note that most of the cases cited to support her position relate to the use of the term "comprising" in claims to compositions or articles of manufacture, where indeed additional ingredients or further elements can be included by the term. The sole case cited relating to method claims, *Invitrogen Corp. v. Biocrest Mfg.*, as quoted by the Examiner, agrees with

Applicants' Representative's assertion; to wit, "The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps." (Emphasis added.) The Examiner should note that there is nothing indicating that the case stands for the proposition that structures for carrying out any particularly recited step can be modified beyond what is described expressly in the claim.

Nonetheless, so as to advance the prosecution of the application, the claims have been amended in a fashion that makes clear that the p97 utilized in the claimed method is not conjugated to any further moiety, and therefore the present claims are distinct from what is disclosed by Gabathuler and the so the instant rejection should be withdrawn.

Claims 10, 14, 15, 32 and 36-38 stand rejected under 35 USC § 102(e) as anticipated by Jefferies et al. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Again, as has been previously explained and indeed acknowledged by the Examiner, the basis for this rejection is that the Examiner interprets the recitation of "comprising" as the transitional phrase to allow for modification of a specifically recited element of the claim to include further features. Again, Applicants' Representative agrees that the inclusion of further ingredients in a composition or of further elements in an article of manufacture is allowed, but **modification of a specifically recited element is not.** Exemplary of this concept might be the holding from the *Gillette* case cited by the Examiner. While indeed a claim to a razor "comprising" a guard, a cap, and first, second and third blades might be open to inclusion of a fourth blade, the nature of the blades themselves is not open to modification. Thus, for example, were the blades described as a "metal blade", a blade made from a metal and plastic composite would not be included in the claim. Similarly, in the present claims, "soluble p97", which is specifically recited in the claims and is described throughout the specification as just that, should **not** be interpreted as being soluble p97 covalently attached to another moiety.

Nevertheless, to advance the prosecution of the present application, the claims have been amended to expressly recite this characteristic of the p97 used in the invention. Accordingly, the present claims are distinct from what is disclosed by Jefferies and the instant rejection should be withdrawn.

Applicants submit that the present application claims subject matter patentable over the prior art of record. The favorable actions of withdrawal of the standing rejections and allowance of the claims are requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell, Ph.D., Reg. No. 36,623 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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